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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,311	02/12/2004	Michael C. Kilmer	CPE-001	5536

21897 7590 01/09/2008  
THE MATTHEWS FIRM  
2000 BERING DRIVE  
SUITE 700  
HOUSTON, TX 77057

EXAMINER
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POPOVICS, ROBERT J

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/777,311

Applicant(s)

KILMER ET AL.

Examiner

Robert J. Popovics

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-14,16,17,20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,11,12,16,17,20, and 22-25 is/are rejected.
- 7) ☒ Claim(s) 2,3,7-10,13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election of:

**REMARKS**

The applicants are unable to understand the Office Action dated August 24, 2007, which appears to require a restriction between the species of Fig.1 and the species of Fig.7.

On June 28, 2006, the Examiner issued an Office Action requiring an election between the species of Fig.1 and species of Fig.7. A copy of the Office Action is enclosed herewith as exhibit A.

On August 28, 2006, the applicants filed a response to the restriction requirement, a copy at which is enclosed as Exhibit B. The response dated August 28, 2006 indicates that each of the Claims 1-25 is directed to species No. 1 illustrated in Claim 1, and that none of the Claims 1-25 is directed to species No.2 illustrated in Fig.7, and described on page 12, lines 11 and 12.

Moreover, the claims drawn to the circular shape (claims 5, 14 and 20) are each dependent and are respectively dependent upon claims 1, 12 and 16, respectively.

The claims drawn to the this type of filter, i.e., candle, dust, or cartridge (Claims 17, 28 and 19) are each dependant upon Claim 16.

It is therefore respectfully traversed that there be a further restriction to Claims 1-25 (now Claims 1-3 and 5-25 since Claim 4 was earlier canceled).

This traversal notwithstanding, the applicants provisionally elect to prosecute Claims 1-3, 5, 7-14, 16, 17, 20 and 22-25. Claims 6 (non-circular), 15 (non-circular), 18 (dust), 19 (cartridge) and 21 (non-circular) are cancelled.

in the reply filed on October 22, 2007 is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The election/restriction is made FINAL.

It is noted that the non-elected species have been cancelled. Applicants are reminded that dependent claims drawn to non-elected species are subject to rejoinder if they depend from an allowable generic claim.

***Claim Rejections - 35 USC § 112***

Claim 1,5,11 and 12, are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A “plurality of rollers mounted on or near the external surface or surfaces of said porous tube” are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicants do not disclose an embodiment that operates without said rollers. The *only* optional rollers are discussed at paragraph [0024] of the Pre-Grant Publication:

[0024] A third set of rollers, which are optional, are located in the center portion of the filter 10 and are identified as being rollers 74, 76, 78 and 80 which would also have counterparts in the middle section of the filter 10, but which are one the blind side of the filter and are thus not illustrated.

Claims 1,5,11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission

amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: “a plurality of rollers mounted on or near the external surface or surfaces of said porous tube”.

Claim 16,17,20 and 25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. “a porous tube” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without a “*porous*” tube, fluid will not pass through the tube, and cannot be said to be a filter.

Claims 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term “*candle filter*” to describe the invention disclosed is considered misdescriptive. It is unclear what Applicants intend by the recitation “*candle filter*” in the context of the claims and their invention. It is thought that the use of “*candle filter*” by Applicants is intended to convey a particular mounting configuration/orientation of their apparatus. However, it is submitted that those skilled in the art would not view the unrollable filter disclosed by Applicants to constitute a “*candle filter*.” It is submitted that those skilled in the art would only consider conventional tubular filters (e.g., cylindrical cartridges/tubes) to be candle filters. As such, the use of “*candle filter*” is considered misdescriptive, since it

is inconsistent with the normally accepted meaning of the recitation, and as such, would only serve to confuse those reading the claims.

Claims 22, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 22,23 and 24, the recitation "*said porous tube*" appears to lack clear positive antecedent basis.

***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

This action is NOT FINAL.

Any inquiry concerning this communication should be directed to Robert J. Popovics at telephone number (571) 272-1164.

A handwritten signature in black ink, appearing to read 'R. J. Popovics', with a large, stylized flourish extending from the end.

Robert James Popovics  
Primary Examiner  
Art Unit 1797